



Paper No. 13

DAVID L. MCCOMBS
HAYNES AND BOONE
3100 NATIONSBANK PLAZA
901 MAIN STREET
DALLAS, TX 75202-3789

COPY MAILED

JAN 10 2001

**OFFICE OF PETITIONS
A/C PATENTS**

In re Application of :
Zucker, Peckover, and Poore :
Application No. 09/100,671 : DECISION REFUSING STATUS
Filed: 19 June, 1998 : UNDER 37 CFR 1.47(a)
Attorney Docket No. 19010.715 :

This is in response to the renewed petition under 37 CFR 1.47(a), filed on 27 September, 2000.

The petition is again dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to respond, correcting the below-noted deficiencies. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

In their renewed petition, petitioners have submitted a copy of a cover letter, dated 24 July, 2000, addressed to the non-signing inventor, Jeffrey Mark Zucker (Zucker) and sent via Certified Mail. Petitioners have also included a copy of the Certified Mail return receipt, signed by Victorine Zarate as well as an affidavit by April Reasoner.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee; and
- (4) a statement of the last known address of the non-signing inventor.

The instant renewed petition lacks items (1). Although petitioners did mail a copy of the application to Zucker's last known address, the Certified Mail receipt was signed by a person other than Zucker. As such, the showing of record is not sufficient to show that the application papers were actually received by Zucker. Petitioner should send or give Zucker an additional copy of the application (specification including claims, drawings, if any, the declaration). Petitioner should provide a copy of the cover letter transmitting the application papers (specification including claims, drawings, if any, and the Declaration) to the non-signing inventor, or provide details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Additionally, as there is doubt as to whether Zucker received the application, petitioner has not provided proof that the Zucker refused to sign the declaration after reviewing the application. Before a refusal of the inventor to sign the application papers can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers to non-signing inventor for signature.¹ If continued attempts to send or give a copy of the application to, and obtain an executed declaration from, Zucker fail, then petitioner will have shown a refusal to sign the declaration based on conduct.

If there is a written refusal, petitioner should submit a copy of that written refusal. If the refusal was made orally, petitioner must provide details of the refusal in an affidavit or declaration of facts by the person with first-hand knowledge.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

¹ MPEP 409.03(d).

Telephone inquiries concerning this matter may be directed to Petitions Attorney Douglas I. Wood, at (703)308-6918.

 for

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy